

REMARKS

The Final Office Action of July 21, 2003, and the Advisory Action of October 31, 2003 have been received and reviewed. Claims 1, 5-8, 10, 11, 24, 25, 27 and 28 are pending in the application and all pending claims stand rejected. Applicants propose to amend the specification and claims 1, 24, 25, 27 and 28, add new claim 29, and have canceled claims 10 and 11 as set forth herein. All amendments and claim cancellations are made without prejudice or disclaimer. Reconsideration is respectfully requested.

Specification

The specification is to be amended as set forth herein. It is respectfully submitted that no new matter has been added. The amendments add the name of the inventor Menzo J.E. Havenga to the title page and removed the reference (but not the priority claim itself) to the number of the European patent application from which priority was sought.

Rejections under 35 U.S.C. § 112, first paragraph

Claims 1, 5-8, 10, 11, 24, 25, 27 and 28 stand rejected under 35 U.S.C. § 112, first paragraph, as assertedly lacking enablement for a method for delivering a nucleic acid of interest to a human primary chondrocyte. Claims 10 and 11 have been canceled rendering the rejections thereof moot. Applicants respectfully traverse the rejections as set forth herein.

Although applicants do not agree that the claims lack enablement, to expedite prosecution, applicants propose to amend the claims in the following manner. Applicants propose to add the elements of claim 10 to independent claim 1 and to amend claim 1 to recite in part "infecting a primary human chondrocyte in vitro" in accordance with the statement by the Examiner reciting "the as-filed specification and claims ... enable a method of delivering a nucleic acid of interest to a primary human chondrocyte in vitro." (Final Office Action mailed July 21, 2003). Accordingly, as proposed to be amended, independent claim 1, and claims 5-8 depending therefrom, should be considered enabled.

Applicants further propose to add phrase “in vitro” in reference to chondrocytes in independent claims 24, 27 and 28. Thus, claims 24, 25 and 27-28 should also be considered enabled.

Applicants further propose to delete claim 11 and add new independent claim 29 which is claim 11 re-written into independent form. New claim 29 recites in part “infecting a primary human chondrocyte in vitro” and should, thus, also be enabled.

With further regard to claims 27 and 28, it was thought that the proposed amendments to claims 27 and 28 presented in the amendment filed October 21, 2003 would raise new issues under 35 U.S.C. § 112 first and second paragraphs because the last step in the proposed amendments did not relate to the preamble. Accordingly, applicants propose to amend the preamble of claims 27 and 28 to recite a “method of transducing a primary human chondrocyte.” Thus, as proposed to be amended, the last steps of claims 27 and 28 correspond to the preamble.

Reconsideration and withdrawal of the enablement rejections of claims 1, 5-8, 24, 25, 27 and 28 are requested.

Rejections under 35 U.S.C. § 102 or § 103

Claims 1, 5, 6, 7 and 8 stand rejected under 35 U.S.C. § 102(e) as assertedly being anticipated by Wickham et al. (US Pat. 6,455,314) or in the alternative, under 35 U.S.C. § 103(a) as assertedly being obvious over Doherty et al. (Osteoarthritis and Cartilage, Vol. 6, pp. 153-160, 1998). Applicants respectfully traverse the rejections as set forth herein.

Although applicants do not agree that claims 1, 5, 6, 7 and 8 are anticipated or obvious, applicants propose to amend claim 1 to include the subject matter of claim 10. Since claim 10 was not rejected as being anticipated or obvious, claim 1, and amended claims 5, 6, 7 and 8 depending therefrom, should also be free of the cited references.

Reconsideration and withdrawal of the anticipation and obviousness rejections of claims 1, 5, 6, 7 and 8 are requested.

ENTRY OF AMENDMENTS

The proposed amendments to the specification, the proposed amendments to the claims and the addition of new claim 29 should be entered by the Examiner because the amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the amendments do not raise new issues or require a further search. The proposed amendments should also place the claims in condition for allowance since they adopt suggestions of the Examiner. Further, the proposed amendment to claim 1 defines over the cited references. Finally, if the Examiner determines that the proposed amendments do not place the application in condition for allowance, entry is respectfully requested since they certainly remove issues for appeal.

CONCLUSION

In view of the proposed amendments and remarks, applicants respectfully submit that the amended claims define patentable subject matter. If questions should remain after consideration of the foregoing, the Examiner is kindly requested to contact applicants' attorney at the address or telephone number given herein.

Respectfully submitted,



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Date: November 13, 2003

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